

**REMARKS**

Claims 1, 4-10, and 12-16 are pending in this application. By the Office Action, claims 4 and 15 are allowed; claims 5-12 are withdrawn from consideration; and claims 1, 3, 13, 14, and 16 are rejected under 35 U.S.C. §102. By this Amendment, claims 3 and 11 are canceled and claims 1, 14, and 16 are amended. Support for the amendments to claims 1 and 14 can be found in claims 3 and 11 and the specification at page 40, lines 5-7 as originally filed. No new matter is added.

I. Allowable Subject Matter

Applicant thanks the Examiner for the indication that claims 4 and 15 are allowed.

II. Rejections Under 35 U.S.C. §102(e)

Claims 1, 3, 13, 14, and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by Sarkar et al. (U.S. Patent No. 6,465,081) ("Sarkar"). By this Amendment, claims 1 and 14 are amended to incorporate the subject matter of claims 3 and 11, as well as to incorporate a filler:resin ratio of from 0.3:1 to 3:1. Applicant respectfully traverses the rejection with respect to the amended claims.

As amended, independent claim 1 is directed to an image recording material comprising: a substrate having transparency; an image receiving layer provided on one side of the substrate and at which an image can be formed; an image being formable by an electrophotography system on the image receiving layer; and a transparent characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling member comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a resin and filler, the resin and filler being present in a filler:resin ratio of from 0.3:1 to 3:1, and wherein the image can be seen when viewed through the substrate. Independent claim 14 is directed to an image recording material comprising: a substrate having transparency; an image receiving

layer provided on one side of the substrate and at which an image can be formed; an image being formable by an electrophotography system on the image receiving layer; and a characteristic controlling means provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling means comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a resin and filler, the resin and filler being present in a filler:resin ratio of from 0.3:1 to 3:1, and wherein the image can be seen when viewed through the substrate. Such image recording materials are nowhere disclosed in Sarkar.

Sarkar is cited as disclosing an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (Office Action, page 2). According to the Office Action, the ink repellent layer of Sarkar is transparent and corresponds to the side of the substrate wherein the electrophotographic image is formed in the claims, and the ink receptive layer of Sarkar is transparent, comprises resin and filler, and corresponds to the characteristic controlling member in the claims. The Office Action further asserted that the Sarkar substrate is transparent.

The Examiner concluded that, "[s]ince the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer *inherently* functions as [a] glossiness controlling layer that reduces glossiness. Since all three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate" (emphasis added) (Office Action, pages 2-3). However, Sarkar does not disclose all of the limitations of the claimed invention.

A. Sarkar Does Not Teach a Glossiness Controlling Layer

According to Sarkar, the ink receptive layer is coated on the side of the substrate that receives the image (col. 9, Example 9). The ink receptive coating comprises at least one layer of a hydrophilic polymer or blend of polymers and may include additives, such as fillers (col. 5, line 60, to col. 6, line 15). The filler "may be used to modify the mechanical properties of the [ink-receptive] coating" and may include colloidal silica and alumina (col. 6, lines 39-42).

The Office Action argues that the Sarkar ink receptive layer corresponds to the characteristic controlling member of the claims. However, in claims 1, 13, 14, and 16 the characteristic controlling member controls, including reduces, glossiness. For all of the reasons presented in Applicant's previous Amendment, there is no indication in Sarkar that the ink receptive layer has or even could be made to have this capability. In order to anticipate a claim, the cited reference must disclose every limitation of the claim. Since Sarkar does not disclose glossiness control, Sarkar cannot anticipate the claims.

B. Sarkar Does Not Teach a Filler:Resin Ratio of From 0.3:1 to 3:1

Still further, Sarkar does not disclose that the characteristic controlling member comprises a glossiness controlling layer comprising a resin and filler, the resin and filler being present in a filler:resin ratio of from 0.3:1 to 3:1. At most, Sarkar teaches ratios far outside the claimed range.

For example, Example 6 of Sarkar teaches the use of 0.1% polymethylmethacrylate microspheres and 9.9% binder consisting of silicone diamine (7.8%) and tetramethyl xylene diisocyanate (2.1%). In this Example, the ratio of polymeric composition microparticles to binder is about 0.01:1, which is far outside the claimed range of from 0.3:1 to 3:1. Likewise, Example 9 of Sarkar teaches 0.05% polystearylmethacrylate microspheres and 4.15% latex , which gives a ratio of polymeric composition microparticles to binder of also about 0.01:1, which is far outside the claimed range of from 0.3:1 to 3:1.

Accordingly, because Sarkar also fails to disclose the claimed filler:resin ratio, Sarkar cannot anticipate the pending claims.

C. Conclusion

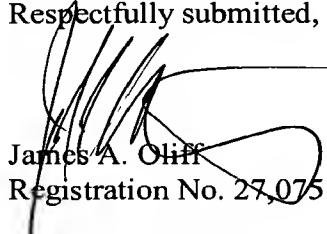
Accordingly, claims 1, 13, 14, and 16 are patentable over Sarkar. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
James A. Oliff  
Registration No. 27,075

Joel S. Armstrong  
Registration No. 36,430

JAO:JSA

Date: November 14, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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